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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,790

08/27/2003

Clark Easter

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/648,790

Applicant(s)

EASTER ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 11/21/2006 to the original application filed 08/27/2003.

Claims 1-33 are currently pending in this application. Claims 1 and 21 have been amended. Claims 1 and 21-22 are independent claims.

Request Continuation for Examination

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2006 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 33 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim is directed to a signal directly or indirectly by claiming *a computer program product* and the Specification (see ¶ 0058) recites evidence where the computer program product is define as a “**signals**” (such as signal bearing media, transmission-type media, light wave transmissions). In that event, the claim is directed to a form of energy which at present the office feels does not fall into a category of invention. Therefore, the cited computer program product is directed to non-statutory subject matter.

The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-33 remain rejected under 35 U.S.C. 102(b) as being anticipating by **Roper** (U.S. 6,270,351, issued 08/07/2001).

As to claim 1:

Roper teaches a method for providing interactive assistance with populating an automated document that includes at least one field (*see the Abstract & col. 2, lines 1-35*), the method comprising:

- selecting an entity to which the document applies (*col.2, lines 1-44 & col.4, lines 32-44*);
- assigning a prioritization to each of the at least one field (*e.g., when a user logs onto the individual education program system, he must enter a login ID and password; col. 8, lines 15-29 & see item StudentID in fig.5*);

- prompting for a response for each of the at least one field (*e.g., Once the student profile is generated ... prompting the user of the system for certain basic information regarding the student ... includes the student's name, age, birthdate, grade, etc...; col. 6, lines 10-18 & see fig. 7*), the prompting varying based on the prioritization of each of the at least one field (*col. 6, lines 1-21*);
- performing a compliance check for each response for the at least one field (*e.g., automatically generates the forms for complying with these regulatory requirements; col. 8, lines 44-56*);
- iteratively revising the prioritization of all of the at least one field upon receiving the response to each of the at least one field (*e.g., the system automatically brings up the student's current IEP record ... The next step in the process for editing an existing individual education plan comprises displaying the student's information screen for the current individual education plan on the computer monitor ... Changes in the student information may be made on this screen by the users of the system*) [*see the discussion beginning at col. 7, line 30*]; and
- prompting for a response for at least one field, the prompting varying based on the iteratively revised prioritization of all of the at least one field (*e.g., before an individual education plan may be created, a student profile is created by entering*

information about the student. The user of the system selects the Enter/Edit Student information option 402 from the main menu 400. Selecting this option brings up a student information screen. Via the student information screen, the user of the system may enter all pertinent information relating to the particular student... records are saved, the individual education program tracking system returns control to the main menu 400... Typically, a state has requirements that must be met before a student can enter a special education plan, such as that provided by an individual education plan. These requirements include an assessment of a student's skills and parental (guardian) authorization. The individual education program tracking system automatically generates the forms for complying with these regulatory requirements. Once the requirements have been met, then an individual education plan may be created for a student) [see the discussion beginning at col.8, line 15].

As to claim 2:

Roper teaches the document is a form (*e.g., form; col.5, lines 20-25*).

As to claim 3:

Roper teaches the form is used for compliance with educational requirements (*e.g., forms required by either or both local school districts and state departments of education; col.2, lines 26-30*).

As to claim 4:

Roper teaches the educational requirements include requirements under the Individuals with Disabilities Education Act (*col.1, lines 16-34*).

As to claim 5:

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig.5*); and automatically populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col.9, lines 1-46 and see fig.9*).

As to claim 6:

Roper teaches performing a legal compliance check of a response for the at least one field (*e.g., automates the completion and submission of various forms as required by a school district or state department of education. The individual education program tracking system integrates and automates procedures that meet a state's or district's legal requirements for administering an individual education plan such as entry qualification evaluations and parental authorization; see the Abstract & col. 2, lines 26-35*).

As to claim 7:

Roper teaches if the compliance check passes, providing an option to lock the document *(e.g., the system locks the individual education plan record in the individual education program database 18; col.13, lines 1-14 and see fig.1).*

As to claim 8:

Roper teaches receiving a selection of a response to the option to lock the document; and if the selection is to lock the document, preventing revision of each of the responses to the at least one field *(e.g., If the user selects the Lock This IEP option 1710, the system locks the individual education plan record in the individual education program database 18 from any further modifications; col.13, lines 1-13 and see fig.1).*

As to claim 9:

Roper teaches prompting a user for security information *(e.g., enter a login ID and password; col.7, lines 15-16).*

As to claim 10:

Roper teaches the entity is an individual *(e.g., an individual; see the Abstract).*

As to claim 11:

Roper teaches storing the automated document with the response to each of the at least one field (*see figs. 9-11*).

As to claim 12:

Roper teaches prompting for a response to each of the at least one field includes: variably highlighting each of the at least one field (*see figs. 7-8*).

As to claim 13:

Roper teaches variably highlighting each of the at least one field includes: highlighting each of the at least one field in a color, the color varying with the prioritization of each of the at least one field (*see figs. 7-8*).

As to claim 14:

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig. 5*); and automatically populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col. 9, lines 1-46 and see fig. 9*); and highlighting each of the at least one field containing automatic populating (*see figs. 7-8*).

As to claim 15:

Roper teaches prompting for a response to each of the at least one field is selected from, among other things, prompting for an optional response (*e.g., selection of the Enter/Edit Student Information of the main menu; col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

As to claim 16:

Roper teaches selecting an entity to which the document applies includes: searching a repository containing at least one entity (*col.6, lines 22-58 and see fig.1*).

As to claim 17:

Roper teaches providing an option to select the automated document from a plurality of documents (*col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

As to claim 18:

Roper teaches generating the plurality of documents via a search (*col.5, line 59-col.6, line 58*).

As to claim 19:

Roper teaches the automated document is associated with a meeting (*col.9, line 47-col.10, line 7 and see fig.12*).

As to claim 20:

Roper teaches the meeting includes at least one event (*col.9, line 47-col.10, line 7 and see fig.12*).

As to claim 21:

It is directed to a system for performing the method of claim 1 above, and is similarly rejected under the same rationale.

As to claim 22:

The rejection of claim 21 above is incorporated herein in full. Additionally, Roper teaches a processor (*e.g., the server 10; col.4, line 3*); a user interface (*e.g., Web server; col.4, line 20*); and a repository (*e.g., a central database; col.4, lines 52-53*).

As to claim 23:

Roper teaches the processor is housed on a terminal (*e.g., a personal computer; col.4, lines 4-5*).

As to claim 24:

Roper teaches the terminal is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

As to claim 25:

Roper teaches the processor is housed on a server (*e.g., the server 10; col.4, line 3 and see fig. 1*).

As to claim 26:

Roper teaches the server is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

As to claim 27:

Roper teaches the server is coupled to a network (*e.g., the network; col.4, lines 5-16 and see fig. 1*).

As to claim 28:

The use of the Internet is inherent to the system of Roper.

As to claim 29:

Roper teaches the server is coupled to the network via a coupling (*col.4, lines 3-16*).

As to claim 30:

Roper teaches the coupling is selected from a group consisting of a wired connection, a wireless connection, and a fiberoptic connection (*e.g., see fig.1 and the accompanying text beginning at col.3, line 63*).

As to claim 31:

Roper teaches the repository is housed on a server (*e.g., the server 10; col.4, line 3 and see fig.1*).

As to claim 32:

It includes the same limitations as claim 27, and is similarly rejected under the same rationale.

Response to Arguments

5. Applicant's arguments filed 11/21/2006 have been fully considered but they are not persuasive.

Applicant argues in substance that *Roper does not teach providing interactive assistance with populating an automated document that includes at least one field, the method*

including at least performing a compliance check of each response for the at least one field [Remarks, page 11].

In response, the Examiner respectfully submitted that Roger's teachings "*automates the completion and submission of various forms as required by a school district or state department of education. The individual education program tracking system integrates and automates procedures that meet a state's or district's legal requirements for administering an individual education plan such as entry qualification evaluations and parental authorization*" (see the Abstract; col. 2, lines 26-35 and col. 8, lines 44-56) meets the limitations as broadly claimed by Applicant.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Pocock US Pat. No. 6,464,505 Issued: Oct. 15, 2002
- Easter et al. US Pub. No. 2003/0236796 A1 Pub. Date: Dec. 25, 2003
- Easter et al. US Pub. No. 2004/0044684 A1 Pub. Date: Mar. 4, 2004
- Anderson et al. US Pub. No. 2005/01022834 A1 Pub. Date: May 12, 2005

- R. Silverstein, "*A User's Guide to The 1999 IDEA Regulations*," March 18, 1999,
Revised May 7, 1999.

Contact information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am - 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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